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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,418	08/10/2000	Christopher E. Axe	021756-018700US	6284

51206 7590 01/08/2007
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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	01/08/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/636,418
Filing Date: August 10, 2000
Appellant(s): AXE ET AL.

David B. Raczkowski of Townsend and Townsend and Crew LLP
For Appellant

EXAMINER'S ANSWER

This examiner answer is in response to the substitute Appeal Brief filed 10/4/2006 appealing from the Final Office Action mailed 1/27/2005.

The original Appeal Brief was filed 11/16/2005; and the original Examiner's Answer was dated 2/10/2006. Appellant submitted a Reply Brief on 3/29/2006, which was noted and entered into the record on 6/13/2006. The undocketed Appeal was returned to the examiner by order of the Board of Patent Appeals and Interferences on 6/20/2006. A first substitute Appeal Brief was submitted on 8/15/2006, but was found to be defective for formality reasons.

(1) Real Party in Interest

A statement identifying by name the real party of interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-35.

Claims 1-33 and 35 stand rejected as recited in the appeal brief.

The rejection of claim 34, made under 35 USC 112, as failing to comply with the written description requirement, is withdrawn. However, claim 34 remains rejected under 35 USC 102(b), as recited in the appeal brief.

The rejection of claim 34, made under 35 USC 101, as being directed to nonstatutory subject matter, is withdrawn. However, claim 34 remains rejected under 35 USC 102(b), as recited in the appeal brief.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Withdrawn Rejections

The following grounds of rejection are not presented for Review on Appeal because they have been withdrawn by the examiner. The rejections of claim 34, made under 35 USC 112, as failing to comply with the written description requirement, and 35

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USC 101, as being directed to nonstatutory subject matter, are withdrawn. However claim 34 remains rejected under 35 USC 102 as recited in the appeal brief.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- US Patent 6,167,383 to Henson, filed 9/22/1998, patented 12/26/2000.
- US Patent 6,161,114 to King et al. filed 4/14/1999, patented 12/12/2000
(hereinafter King).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 1-3, 6-9, 14-17, 23-30, and 32-34 rejected under 35 USC 102(b)
as being anticipated by Henson
- Claims 4, 5, 11-13 and 18-20 rejected under 35 U.S.C. 103(a) as being
unpatentable over Henson
- Claims 10, 21, 22, 31 and 35 rejected under 35 U.S.C. 103(a) as being
unpatentable over Henson in view of King.

(10) Response to Argument

Regarding independent claim 1:

Regarding appellant's argument that: "*the cited art does not teach "(d) receiving a placement of the selected object"*" (page 6, section C.1.a, first paragraph). Henson clearly discloses visually configuring a product by placing a plurality of selectable components into a plurality of slots. See for example Henson's Fig. 3A, at reference sign 76 where the placement of the previously selected object is received (shown as "*Hard Drive*"). Henson's Fig. 3A is a snapshot of the configuring process at the point in time when the placement is received.

Regarding appellant's argument that: "*There is, therefore, no reason for Henson to teach a separate placement of a selected item because the item is already within its field*" (page 6, section C.1.a, second paragraph). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*separate placement*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding appellant's argument that: "*there does not appear to be a separate teaching of receiving of a placement of the selected object*" (page 6, section C.1.a, third paragraph) and "*the Applicants are unable to find teaching of both a "selection" and a separate "placement of the selected object" in Henson "*" (page 6, section C.1.a, third paragraph). In response to appellant's argument, consider again Henson's Figure 3A, at

reference sign 77. Reference sign 77 is directed toward a drop down list box, which is well known in the graphical user interface arts. The drop down list box would have a default value. A user would activate the dropdown list box by selecting (usually by clicking with a mouse) the upside-down triangle. The system would then display a list of items (retrieved from memory) for the user to select from. After the system received a selection from the user (by selecting a value from the list with the mouse), the dropdown list box would receive a new value (i.e. the selected value). Therefore, a dropdown list box, as disclosed by Henson, would anticipate receiving a selection of an object, and thereafter, receiving a placement of the object.

Regarding appellant's argument that: *"the cited art does not teach "(b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed"* (page 7, section C.1.b, first paragraph). In response to appellant's argument, consider again Henson's Figure 3A. Henson discloses in Figure 3A, an initialized configuration layout with a plurality of components and slots (shown at reference signs 75 and 77). Also shown in Figure 3A are selectable objects (shown as dropdown list boxes) where a selection can be made for the designated slot. The selected object (for example "96MB SDRAM" shown at reference sign 77) is placed in the slot as shown.

Regarding appellant's argument that: *"In these claim limitations, the phrase "in which the selected object may be placed" characterizes "the plurality of slots." Thus, a selected object may be placed in one of a plurality of alternative slots"* (page 7, section C.1.b, first paragraph). In response to applicant's argument that the references fail to

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show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*alternative slots*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding appellant's argument that: "*The Applicants are unable to identify any teaching within Henson that suggests that a user can "place" or "move" an item to alternative fields*" (page 7, section C.1.b, third paragraph). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*move an item to alternative fields*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner is satisfied with appellant's supplied American Heritage Dictionary definition for the word "*placement*". However, the two definitions provided by appellant suggest ambiguity. If the claimed limitation of "*receiving a placement of the selected object*" is interpreted in light of the two definitions, "*a) the act of placing or arranging, or b) the state of being placed or arranged*", the examiner contends that the second definition is appropriate, which renders the meaning of the limitation to be "*receiving a state of being placed of the selected object*" and not "*receiving the act of placing of the selected object*". In either case the definition provided clearly does not include "*rearranging*".

Regarding independent claim 2:

Regarding appellant's argument that: "*the cited art does not teach "(g) storing a new set of constraints" much less that the stored constraints [are] based on the placement of the selected object" as recited in claim 2*" (page 9, section C.2.b, first paragraph) and the supporting position of the applicant that "*constraints" are rules regarding, for example, what objects can be combined in a product*" (page 9, section C.2.b, second paragraph). While the examiner contends that Henson's "Save my Cart" feature, as shown at reference sign 106 in Figure 6, discloses: "*storing a new set of constraints*", where constraints have been interpreted to mean a "*particular system configuration*", Henson also discloses constraints if interpreted to mean "*rules*". The claim limitation recites: "*storing a new set of constraints based on the placement of the selected object*". Consider Henson's online configuration process as shown in Figures 3A and 4. When the user initially is presented with the system configuration screen shown in Figure 3A, a default set of constraints are in effect. The constraint categories (shown as "*Memory*", "*Hard Drive*", "*Monitor*", "*Video Card*" etc.) are each represented by a dropdown list box selection slot. As the user sets one of the constraints (say, for example, selecting a "*Memory*" constraint value) a new set of constraints is stored relative to the other dropdown list box selections. So, if the "*Memory*" feature is set to a constraint of "*96MB SDRAM*", the "*Hard Drive*" and "*Video Card*" constraint sets would be restricted to certain values, and these new values would be stored relative to the

constraint category. Therefore, Henson discloses storing a new set of constraints based on the placement of the selected object.

Regarding independent claim 9:

Regarding appellant's argument that: *"the cited art does not teach "a user intelligence communicatively coupled to the user interface, for receiving a set of constraints from a remote inference engine"* (page 10, section C.3.b, first paragraph), the examiner contends that the claim limitation language has a broad scope, and has been interpreted to mean a user operating the system. Henson discloses a user operating a product configuration system. Henson recites: *"The configurator is provided for configuring a computer system with options selected according to a prescribed user input"* (column 2, lines 65-67).

In response to appellant's argument that *"user intelligence" refers to logic that is on a side of a client-server architecture remote from the inference engine, and is used to distinguish this logic from "server side intelligence."* For example FIG. 1 illustrates an embodiment in which *"User intelligence 140"* includes *"Forward-looking rules table Storage 150," "Forward-looking rules implementor 155" "Forward-looking rule table Interpretor 145" and "Encoder of implementation 160"* (page 10, section C.3.b, first paragraph), the examiner agrees with appellant that these features (as shown in Figure 1) would help to distinguish *"user Intelligence"* and limit the broad scope of the claim language. However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., “*logic that is on a side of a client-server architecture remote from the inference engine*”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding independent claim 16:

Regarding appellant’s argument that: “*Henson does not teach “(c) causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot, if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules ”* (page 11, section C.4.b, first paragraph), The examiner contends that Henson discloses this feature. In Henson’s Figure 3A, an indication that the selected object is not compatible with the current configuration is shown at reference sign 86 (shown as the message “*This option is not compatible with ...*”). This configurator-generated message is generated during an attempted placement of the selected object in the selected slot.

Appellant also argues that: “*An advantage of the indication as recited in Claim 16 is seen in FIGS. 3 and 6 of the specification, wherein the indication is provided while a user is dragging a selected object toward a slot but before the object is dropped (e.g., placed) in the slot*” (page 12, section C.4.b, third paragraph). In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “*the indication is provided while a user is dragging a selected object toward a slot but before the object is dropped (e.g.,*

placed) in the slot") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claim 23:

Regarding appellant's argument that: "*Henson does not teach "wherein the configuration layout is representative of a physical layout of the product"* (page 12, section C.5.b, first paragraph), the examiner contends that the claim language has a broad scope. Henson discloses in Figure 3A an image of a computer in the upper right hand corner of the configurator screen that represents the physical layout of the product being configured.

Appellant also argues that: "*There is no teaching within Henson that this order is a representation of the physical order or spatial relationship of these elements in the computer product being purchased"* (page 13, section C.5.b, third paragraph). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*a representation of the physical order or spatial relationship of these elements in the computer product"*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding independent claim 24:

Appellant's arguments are significantly the same as the arguments for claim 16. The examiner's response to these arguments is presented above.

Regarding independent claim 29:

Regarding appellant's argument that: *"the cited art does not teach "specifying a second configuration of the selected product by selecting a first of the plurality of objects for placement in a first of the one or more slots" much less where "the placement of the first of the plurality of objects in the first of the one or more slots being limited by a subset of the plurality of configuration rules"* (page 15, section C.7.b, first paragraph), the examiner contends that Henson discloses these features. In order to get a proper perspective of the *"specifying a second configuration"* limitation, a review of the claim as a whole is required. Claim 29 calls for:

A method of configuring a product for purchase, the method comprising:
selecting the product for purchase, the product having a plurality of alternative configurations, the plurality of alternative configurations being limited by a plurality of configuration rules;
viewing a first configuration of the plurality of alternative configurations and a plurality of objects, within a graphical user interface, the viewed first configuration including one or more slots within which at least one of the plurality of objects may be placed;
specifying a second configuration of the selected product by selecting a first of the plurality of objects for placement in a first of the one or more slots, the placement of the first of the plurality of objects in the first of the one or more slots being limited by a subset of the plurality of configuration rules, the selection of the first of the plurality of objects being made using the graphical user interface.

Appellant concurs with the examiner's position that Henson discloses *"A method of configuring a product for purchase ..."* and *"selecting the product for purchase ..."*.

Appellant further concurs with the examiner's position that Henson discloses "*viewing a first configuration of the plurality of alternative configurations and a plurality of objects ...*" with the exception that Appellant finds the examiner's interpretation of the "*placed objects*" features as improper. The examiner's response to the "*placed objects*" argument is contained above in reference to claim 1. The argument addressed herein is directed toward the third and final limitation "*specifying a second configuration ...*". The second limitation is directed toward a "*first configuration of the plurality of alternative configurations and a plurality of objects, within a graphical user interface, the viewed first configuration including one or more slots within which at least one of the plurality of objects may be placed*". Henson discloses this first configuration. Henson's Figure 5 provides a somewhat different view of the configurator than that of figure 3A. Figure 5 is a first configuration. At reference sign 92 is shown the plurality of objects for the one or more slots, where the first configuration state is provided to the user as a default state (see the radio button that control the object selection). The user would specify a second configuration by changing the button for the desired object. Placement of the object is limited by a subset of rules associated with each of the object choices. The rules for these choices are the same as the rules described above in relation to the dropdown list boxes of Figure 3A. In fact the configurator view shown in Figure 5 is the same as that of Figure 3A. Reference sign 94 of Figure 5 is directed toward the control for switching between "*Drop-down list view*" and the "*View all systems option view*". The configuration rules are by their very nature broken down into various subsets of rules associated with the configuration categories. For instance the "*Monitor*" configuration category

selections do not affect other configuration categories, but the "Video Card" configuration category selection would be affected by the "Memory" configuration category selection.

Regarding claim 30:

Appellant's arguments are significantly the same as the arguments for claim 29. The examiner's response to these arguments is presented above.

Regarding claims 4 and 5:

The Appellant argues that: *"the cited art does not teach a "forward looking rules table" (page 17, section D.1.b, first paragraph). Henson discloses configuration rules that control the configuration of the product (as described above). Henson fails to explicitly describe the use of a "forward looking rules table". However, Henson discloses a "Database" (shown in Figure 1 at reference sign 24), wherein data in a database is represented as tables. Henson recites: "The database 24 provides information to the configurator 18" (column 4, lines 64-65) and "The present online store takes into account that some choices are not as right as others. Thus the configurator of the present online store has been made smarter" (column 5, lines 38-40) and "The present online store takes into account that some choices are not as right as others. Thus the configurator of the present online store has been made smarter" (column 5, lines 38-40). Reference sign 76 of Figure 3A discloses the placement of the selected object (shown as "Hard Drive"). Henson also recites: "the configurator 18 which are being*

driven by the database 24 are illustrated. In essence, the entire configurator 18 is being driven by the database. As mentioned, the configurator 18, shopping cart 20, and checkout 22 are each part of the commerce application 14 and prone to be driven by the database 24" (column 5, lines 55-60).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to describe the database feature of Henson as having a forward looking rules tables because the data base provides *"the database is provided for dynamically supplying configuration options to the configurator"* (Henson, column 3, lines 9-10).

Despite the iteration of the *"forward looking rules table"* description from the specification by the Appellant on page 18 (middle of the page), one of ordinary skill in the art would have interpreted this feature to be equivalent to the common *"Lookup table"* prevalent and well know in the database arts, and would not have to consult the specification to understand the function of this feature. The *"looking up"* (claim 4) and *"creating"* (claim 5) of lookup tables is also well known in the art. Appellant has characterized Henson's rules as *"backward looking"*, however Henson's rules would satisfy Appellants definition that forward looking rules would be *"constraints on the next selection by a user"* (quote from the specification as found in the brief on page 18,in the middle of the page). Henson discloses constraints on the next selection by the user as described previously in regard to claim 1.

Regarding claim 11:

The Appellant argues that: *"the cited art does not teach a "interpretor," "implementor," or "encoder" recited in claim 11"* (page 19, section D.2.b, first paragraph). As described above, the examiner has taken the position that the *"user intelligence"* of claim 9 is a user operating the configuration system. The examiner further contends that *"interpretor," "implementor,"* and *"encoder"* are mental processes performed by the user using the system. The user can interpret the constraint messages from the system. The user can implement (by making informed decisions) the constraints as forward looking rules (i.e. *"this option is not compatible ..."*). The user can encode (select a button or dropdown list option) and send data regarding a user's current selection (*"Add to cart"* feature in Figure 3B at reference sign 74) to the inference engine.

Regarding claim 12:

Appellant's arguments are significantly the same as the arguments for claims 1 and 9 combined. The examiner's response to these arguments is presented above.

Regarding claim 19:

The Appellant argues that: *"the prior art does not teach a "user intelligence" that is "stored on the client device"* (page 20, section D.4.b, first paragraph). The examiner's response to the argument related to the *"user intelligence"* is described above in relation to claim 9. Regarding appellant's argument related to *"stored on a client device",*

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Henson discloses storing new constraints, as described above in relation to claim 2. Henson also discloses the user intelligence (i.e. the user) interpreting and implementing the set of constraints. At the point in time when the user enters into the system his intelligence (by selecting objects), would inherently be transferred to the system and stored there. However, Henson fails to explicitly describe a client device or a remote host device. However, Henson discloses in Figure 2, a client (at reference sign 40) connected remotely via the Internet (at reference sign 38) to a remote host (at reference sign 10, described as "On-Line Store"). Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to describe the system configuration of Henson as a client-host type of configuration to provide *"an online store user interface for enabling custom configuration, pricing, and ordering of a computer system via the Internet"* (Henson, column 1, lines 19-21).

Regarding claims 10, 21, 22 and 31:

The Appellant argues that: *"the examiner has not provided sufficient motivation for the combination of King and Henson"* (page 21, section E.1.b, first paragraph). The King reference is King et al., US Patent 6,161,114 (hereinafter King). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

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See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation suggested by the examiner "*to improve document production*" in response to the "*drag and drop*" limitation of the claims is meant to indicate that the combination of references would obviously improve the production of the relative system (in the case of King, a document system; in the case of Henson, a product configuration system).

Regarding claim 22:

The Appellant argues that: "*the cited art does not teach "wherein causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot includes not allowing the dragged one of the plurality of objects to be dropped in the one of the one or more slots" as recited in Claim 22*" (page 22, section E.4.b, first paragraph). Henson discloses the user interface indicating the selected object cannot be placed in the selected slot in figure 3A at reference sign 86 (shown as the message "*This option is not compatible with ...*"). However, Henson fails to disclose drag and drop functionality. King discloses the use of drag and drop functionality. King recites: "*In some embodiments, powerful content processing capabilities make assembly of content from a wide variety of resources (another disk, over a network, from the Internet, for example) as simple as executing a drag and drop action*" (column 6, lines 8-11).

Regarding claim 35:

The Appellant argues that: *"the cited art does not teach "causing the graphical interface to indicate that the selected object cannot be placed in the selected slot occurs while attempting to place the selected object in the selected slot"* (page 23, section E.6.b, first paragraph). Henson discloses the user interface indicating the selected object cannot be placed in the selected slot in figure 3A at reference sign 86 (shown as the message *"This option is not compatible with ..."*). Henson further discloses: *"With respect to validation 34, a system option compatibility warning is issued"* (column 8, lines 7-8) and *"First, a general alert 84 to the presence of any number of potentially problematic system options is displayed on the web page, for example, near the top of the page. Secondly, an option compatibility icon 86 is displayed adjacent to each potentially incompatible option's position in the configurator"* (column 8, lines 19-24). Clearly, Henson discloses that when the user attempts to select or place an object that is incompatible in a selected slot, the system will indicate to the user that the object cannot be placed in the selected slot.

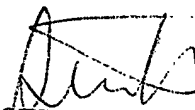
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Gregory J. Vaughn
Patent Examiner
Art Unit 2178
December 21, 2006

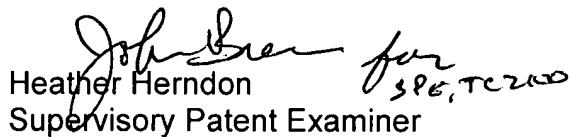


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